

REMARKS/ARGUMENTS

Restriction Requirement

The Office Action has set forth a restriction requirement. Applicants elect, with traverse, the claims of Group I (claims 1-14). Reconsideration of the requirement for restriction is respectfully requested for the reasons discussed below.

Discussion of the Restriction Requirement

There are two separate criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the Examiner if restriction is not required. Both of these criteria must exist for a restriction requirement to be proper, and “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions” (M.P.E.P. § 803).

The Office Action alleges that the inventions defined by the claims of Groups I-VI are distinct and would involve searches that are not co-extensive, thus placing an undue burden on the Examiner. Applicants submit that, even if the claims are directed to independent and distinct inventions, it would not be unduly burdensome to search all of the alleged inventions together. In this respect, the claims of Groups I-V relate to inhibitors or mutants of FGF-4, or methods of use thereof. Accordingly, the examination of at least some of the groups set forth in the Office Action (e.g., Groups I-V) would involve overlapping searches and would certainly not be unduly burdensome. In the absence of such a “serious burden,” the restriction requirement is improper even if groups of claims are drawn to distinct or independent inventions.

Conclusion

In view of the foregoing, the restriction requirement is improper and should be withdrawn. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned agent.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Mel Kolom", written in black ink.

Melissa E. Kolom, Reg. No. 51,860
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: March 6, 2006